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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,072	08/28/2001	David Goodman	**19-0088	5656

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EXAMINER	
LEROUX, ETIENNE PIERRE	

ART UNIT	PAPER NUMBER
2161	

MAIL DATE	DELIVERY MODE
12/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/941,072

Applicant(s)

GOODMAN ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claim Status:

Claims 1-43 are pending. Claims 1-43 are rejected as detailed below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-15, 19-27, 29-35 and 39-42 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,483,602 issued to Haneda (hereafter Haneda), as best examiner is able to ascertain.

Claims 1, 20, 33, 40, 41, 43:

Haneda discloses:

a) determining whether or not the storage medium has been assigned a unique volume label and a unique label identifier [the identification code on the user's disk is compared with the identification code attached to the image data preserved on the lab's disk in the laboratory system, col 20, lines 25-30]

Note:

(1) storage medium is interpreted as user's disk, col 15, lines 5-10]

(2) unique volume label is interpreted as processing serial number, col 15, line 38

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(3) unique label identifier is interpreted as film number, col 15, line 43 on a bar code label, col 19, lines 5-10, Fig 10]

b) if the storage medium has not been assigned a unique volume label and a unique label identifier, then

(i) determining a unique label identifier for the storage medium [identification code is stored on the original film, on the user's disk, Fig 10, on the lab's disk 16, Fig 10, col 4, lines 8-15, col 19, lines 50-65]

(ii) determining a unique volume label for the storage medium [processing serial number, col 15, lines 35-40],

(iii) writing the unique volume label onto the storage medium [bar code label in Fig 10, col 19, lines 5-10]

Note:

(1) writing the unique volume label onto the storage medium is ambiguous because it is typically interpreted as entering data directly onto the storage medium as opposed to a label which is affixed to an external surface of the user's disk. However, claim 6 includes a bar code label and so that will be the interpretation.

(iv) providing a command to generate a label based on the unique label identifier, the label to be associated with the storage medium [print label, Fig 10, col 19, lines 55-60]

c) updating a database based on files, if any, added to or deleted from the storage medium [lab's disk includes an enormous amount of file image data, col 22, lines 55-60, original digital image

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data is stored on a laboratory recording medium together with an identification code identifying the roll of film, abstract, when the fixed period of time elapses, the image data is erased, col 20, lines 30-35]

Claim 2, 21:

Haneda discloses d) synchronizing the database with a database on a device apart from the read/write machine [reading the bar code on the user's disk, comparing identification codes and printing photographs, col 20, lines 50-60]

Claim 3, 13, 32:

Haneda discloses the read/write machine is a personal computer [Fig 2, 30] and the device is a handheld device [bar code reader 36, col 19, lines 5-15]

Claim 4, 22, 23 :

Haneda discloses wherein the device is an untethered handheld device [bar code reader 36, col 19, lines 5-15]

Claim 5, 4:

Haneda discloses wherein the read/write machine is a computer with at least one of (a) a floppy disk drive, (b) a CD ROMK drive, (c) a ZIP drive, and (d) a DVD drive [col 15, lines 7-10]

Claim 6, 25:

Haneda discloses wherein the label based on the unique label identifier is a bar code label [Figs 10, 12]

Claim 7, 26:

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Haneda discloses wherein the act of determining a unique volume label is based, at least in part, on state information accessible to the read/write machine [col 15, line 39, processing serial number]

Claim 8, 27:

Haneda discloses wherein the state information is a count sequence [col 15, line 39, processing serial number]

Claim 10, 29:

Haneda discloses (d) accepting information read from a label associated with the storage medium without reading the storage medium, (e) converting the accepted information into a database key, (f) requesting records from a database instance using the database key (g) accepting records in response to the request and (h) rendering information about the accepted records [Fig 2, col 19, lines 7-20, col 20, lines 50-55]

Claim 11, 30:

Haneda discloses wherein the label associated with the storage medium is a bar code and wherein the information read from the label is accepted from a bar code scanner [Fig 2, 36].

Claim 12, 31:

Haneda discloses wherein the information about the accepted records rendered includes file names [Fig 14, 15].

Claim 14:

Haneda discloses wherein the read label is converted into a database key by the handheld device, the records are requested from a database instance using the database key by the

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handheld device, and the records are accepted in response to the request by the handheld device

[Fig 2, col 23, lines 13-18, roll of film is specified by selecting its pet name]

Claim 15, 35:

Haneda discloses:

- (a) accepting one or more search parameters [user requests extra prints from laboratory, col 4, lines 5-15, user retrieves according to frame numbers of the film, col 3, lines 55-60] selected from a group of parameters consisting of (A) file name, (B) file size, (C) file author and (D) file type [col 54, lines 35-40]
- (b) generating a query based on the search parameters [user requests extra prints from laboratory, col 4, lines 5-15]
- (c) accepting one or more records returned in response to the query generated [order data transmitted to the laboratory system, col 4, lines 30-40]
- (d) rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium [photographs are printed, col 4, lines 40-48, user is provided with printer, col 5, lines 25-30, creating a slide-show, col 9, lines 45-60]

Claim 16, 36

Haneda discloses accepting information read from the machine-readable labels, if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans [col 23, lines 1-10]

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Claim 17, 37

Haneda discloses if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second identifier, said second identifier able to be perceived by humans [col 23, lines 1-10, null return]

Claim 19, 39:

Haneda discloses wherein each of the labels include human-readable part, and wherein the information associated with each of the one or more labels accepted corresponds to the human-readable part of the labels [Figs 8 and 9].

Claim 34:

Haneda discloses means for synchronizing the database with a database maintained by a separate machine which created the storage medium [Fig 1, paragraph 36]

Claim 42:

Haneda discloses wherein the information rendered is related to the label associated with the storage medium storing one or more files identified with the one or more records accepted such that a user or scanner can distinguish the storage medium including the label from other storage media [Fig 2]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda in view of US Pat No 4,864,616 issued to Pond et al (hereafter Pond), as best examiner is able to ascertain.

Claim 9, 28:

Haneda discloses the elements of claims 1/15 as noted above but does not disclose wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium. Pond discloses wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium [col 3, lines 35-55]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium as taught by Pond for the purpose of positively identifying a file in storage such that it can be quickly and accurately retrieved.

Claims 18 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda in view of US Pat No 5,971,279 issued to Raistrick et al (hereafter Raistrick), as best examiner is able to ascertain.

Claim 18, 38:

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Haneda discloses the elements of the claimed invention as noted above but does not disclose wherein the first indicator is a first audible sound, and the second indicator is a second audible sound. Raistrick discloses wherein the first indicator is a first audible sound, and the second indicator is a second audible sound [Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include above limitation for the purpose of providing the user with a quick response which does not require an additional eye and/or hand movement.

Response to Arguments

Applicant's arguments filed 11/23/2007 have been fully considered but they are moot based on above new grounds of rejection.

Conclusion

In view of the Appeal Brief filed on 11/23/2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth above.

To avoid abandonment of the application, appellant must exercise one of the following two options:


(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

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been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



APU MOFIZ
SUPERVISORY PATENT EXAMINER

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Mondays through Friday between 8:00 am and 4:30 pm.

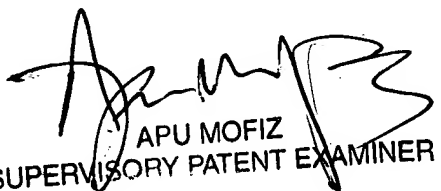
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

12/18/2007



APU MOFIZ
SUPERVISORY PATENT EXAMINER